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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Isao Sakurai

6667/28

7065

757

7590

10/30/2006

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/650,162

Applicant(s)

SAKURAI ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2, 14 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13, 15-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 2, 2006 has been entered.

### ***Withdrawn Rejections***

2. The 35 U.S.C 102(e) rejection of claims 1 – 5, 8, 10, 11, 14, 16 – 18, 20 and 21 as anticipated by Hennen in the office action dated April 11, 2006 is being withdrawn due to Applicant's amendments in the response dated August 18, 2006.

3. The 35 U.S.C 103(a) rejection of claims 6, 7, 9, 12, 13, 15 and 22 over Hennen in view of Shikinami et al. in the office action dated April 11, 2006 is being withdrawn due to Applicant's amendments in the response dated August 18, 2006.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3 – 5, 8, 10, 11, 16 – 18, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hennen (USPN 6,982,107).

Hennen discloses a pressure sensitive adhesive article (Column 1, lines 7 – 8) comprising a pressure sensitive adhesive layer (Column 8, line 12) mainly formed of polyurethane resin (Column 8, line 16) and free of silicone compound in an amount of 500 g/m<sup>2</sup> or less (Column 8, lines 12 – 57) and a releasing agent layer mainly formed of polyolefin resin (Column 3, lines 60 – 65) selected from polyethylene, polypropylene, ethylene  $\alpha$  copolymers, olefin based thermoplastic elastomer and mixtures thereof (Column 3, lines 25 – 45; Column 6, lines 15 – 23) having a density equal to or less than 0.94 g/cm<sup>3</sup> (Column 5, lines 62 – 67), which inherently has a numerical average molecular weight of about 15,000 to about 500,000 determined by GPC based on the composition, adhered to the pressure sensitive adhesive layer (Column 3, lines 12 – 13), wherein the releasing agent layer that faces the pressure sensitive adhesive layer has a tension of almost zero, thereby being less than 22mN/m (Column 7, lines 26 – 46) as in claims 1 – 3, 5, 11 and 16. With regard to claims 4 and 8, the pressure sensitive adhesive sheet includes a base material of plastic film on which the pressure sensitive adhesive is provided (Column 3, lines 25 – 27), and the release sheet includes a release sheet base material on which the releasing agent layer is provided (Column 4, lines 65 to Column 5, line 1; Column 6, lines 42 – 46), the release sheet being removable attached to the pressure sensitive adhesive layer of the pressure sensitive adhesive sheet through the releasing agent layer thereof (Column 7, lines 26 – 46). As in claim 10, the pressure sensitive adhesive article is a tape (Column 8, lines 67 to Column 9,

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line 1), which comprises a base material having both surfaces with a pressure sensitive adhesive on side and a releasing agent layer on the other being wound into a roll form until it is used (Column 9, lines 1 – 3; Column 7, lines 56 – 67). The polyolefin resin is selected from the group consisting of a polyethylene resin whose density is 0.9 to 0.922 g/m<sup>2</sup> (Column 5, lines 62 – 67) and an olefin based thermoplastic elastomer whose density is 0.86 to 0.88 g/m<sup>2</sup> (Column 6, lines 21 – 23), wherein the thermoplastic elastomer is an ethylene-octene copolymer (Column 6, lines 15 – 21) as in claims 17 and 18. With regards to claims 20 and 21, an adhesion enhancing layer is provided between the release sheet base material and the release agent layer, wherein the release sheet base material is a plastic film (Column 3, lines 25 – 27) and the adhesion enhancing layer is made of polyethylene resin (Column 4, lines 53 – 60).

With regard to the release agent having a numerical average molecular weight of about 15,000 to about 500,000 determined by GPC based on the composition, it is inherent that the polyolefin resin of Hennen would meet the numerical average molecular weight as claimed since the releasing agent is selected from polyethylene, polypropylene, ethylene  $\alpha$  copolymers, olefin based thermoplastic elastomers and mixtures thereof (Column 3, lines 25 – 45; Column 6, lines 15 – 23) having a density equal to or less than 0.94 g/cm<sup>3</sup> (Column 5, lines 62 – 67), which overlaps the Applicant's claimed characteristics of the releasing agent layer as shown by the limitations presented by claim 17. Therefore, it would be inherent that the polyolefin resins of the release agent of Hennen would have a numerical average molecular weight of about 15,000 to about 500,000 determined by GPC based on the composition.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 7, 9, 12, 13, 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennen (USPN 6,982,107) in view of Shikinami et al. (USPN 4,855,077).

Hennen discloses a pressure sensitive adhesive article (Column 1, lines 7 – 8) comprising a pressure sensitive adhesive layer (Column 8, line 12) mainly formed of polyurethane resin (Column 8, line 16) and free of silicone compound in an amount of 500 g/m<sup>2</sup> or less (Column 8, lines 12 – 57) and a releasing agent layer mainly formed of polyolefin resin (Column 3, lines 60 – 65) selected from polyethylene, polypropylene, ethylene  $\alpha$  copolymers, olefin based thermoplastic elastomer and mixtures thereof (Column 3, lines 25 – 45; Column 6, lines 15 – 23) having a density equal to or less than 0.94 g/cm<sup>3</sup> (Column 5, lines 62 – 67), which inherently has a numerical average molecular weight of about 15,000 to about 500,000 determined by GPC based on the composition, adhered to the pressure sensitive adhesive layer (Column 3, lines 12 – 13), wherein the releasing agent layer that faces the pressure sensitive adhesive layer has a tension of almost zero, thereby being less than 22mN/m (Column 7, lines 26 – 46). However, Hennen fails to disclose the amount of the gas generated from the pressure sensitive adhesive sheet is equal to or less than 20 mg/m<sup>2</sup>, the pressure sensitive adhesive sheet contains ions from a select group in an amount equal to or less than 20 mg/m<sup>2</sup>, an antistatic layer provided on one or

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both of the surfaces of the base material and the polyurethane resin comprises a resin obtained by reacting a polyol and a polyisocyanate.

Shikinami et al. teach an antistatic layer provided on one or both of the surfaces of the base material (Column 4, lines 62 – 64) in combination with ions from a select group in an amount equal to or less than  $20 \text{ mg/m}^2$  (Column 13, lines 10 – 26) in a pressure sensitive adhesive article, wherein the article is a pressure sensitive adhesive tape which comprises a base material having both surfaces, the pressure sensitive adhesive layer provided on one of the surfaces of the base material and the releasing agent layer provided on the other surface of the base material, wherein the pressure sensitive adhesive tape being wound in a roll form until it is used (Column 4, lines 57 – 58) for the purpose of using the adhesive material as a sticking agent for sticking tapes having an antistatic sticking layer in the fields of industry, agriculture, packaging and electronics (Column 1, lines 30 – 33).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the ions from the select group and an antistatic layer in Hennen in order to have a adhesive material as a sticking agent for sticking tapes having an antistatic sticking layer in the fields of industry, agriculture, packaging and electronics as taught by Shikinami et al.

In regards to the limitations of a wet tension test defined by JIS K 6768, the amount of the gas generated from the pressure sensitive adhesive sheet is equal to or less than  $20 \text{ mg/m}^2$  in

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claims 1 – 3, 6, 12 and 15, one of ordinary skill in the art would have recognized the claimed pressure sensitive article would have a wet tension test defined by JIS K 6768, the amount of the gas generated from the pressure sensitive adhesive sheet is equal to or less than  $20 \text{ mg/m}^2$  since Hennen teaches a pressure sensitive article having the same parameters as the claimed invention. Therefore, one of ordinary skill in the art would readily determine the tension, density and amount of gas generated depending on the end desired results in the absence of unexpected results.

In regards to the limitations of the polyurethane resin comprising a resin obtained by reacting a polyol and a polyisocyanate in claim 22, the combination of Hennen and Shikinami et al. disclose the claimed invention except for the specific materials of the elastomer and polyurethane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the specific materials as the elastomer and to make the polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

8. Applicant's arguments filed August 18, 2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is nothing in Hennen that discloses or teaches the release agent having a numerical average molecular weight of about 15,000 to about 500,000 determined by GPC based on the composition, please the newly presented rejection above.

Applicants argue that the polyolefin resins of Hennen would not have a numerical average molecular weight of about 15,000 to about 500,000 determined by GPC as recited in the instant claims. This is not deemed persuasive since arguments cannot take the place of evidence in the record to overcome a rejection. See MPEP 2145.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

pln